TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Trademark Application
Serial No. 76/494,782

Filed: March 5, 2003

Mark: TIBERO

Official Gazette p. TM 360

TIBCO Software Inc.

Opposer,

Opposer,

V.

Trademark Application
Serial No. 76/494,782

Filed: March 5, 2003

Mark: TIBERO

Published: May 25, 2004

Applicant

BOX TTAB — FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202/3514, on______

<u>NOTICE OF OPPOSITION</u>

TIBCO Software Inc., by and through its undersigned attorneys, believes that it will be damaged by the registration of U.S. Trademark Application Serial No. 76/494,782 for the mark TIBERO in International Class 9 and hereby opposes the same. As grounds for opposition, it is alleged that:

- Upon information and belief, Applicant Tmax Soft Co., Ltd. (hereinafter "Applicant"), is a Korean corporation with an address of Glass tower 19th Floor, 946-1 Daechi 3 Dong, Kangnam-ku, 135-280, Seoul, Republic of Korea.
- 2. Upon information and belief, Applicant seeks to register the mark TIBERO for goods identified as "recording computer operating program; notebook SSMITH 00000180 76494782

07/15/2004 TSMITH

01 FC:6402

300.00 OP

computer; laptop computer; software programmable microprocessors; CD-Rom drive; magnetic tape drive; computer software for use as an enterprise application integration solution, namely, providing integrated interface between various enterprise applications and user applications, which is recorded in floppy disk, CD-Rom, or magnetic tape device, or downloaded from a website." in International Class 9.

- 3. Upon information and belief, this application was filed on March 5, 2003 and was published for opposition on page TM 360 of the Official Gazette on May 25, 2004.
- 4. Opposer TIBCO Software Inc. is a Delaware corporation having a principal place of business at 3303 Hillview Avenue, Palo Alto, California 94304.
- 5. TIBCO Software Inc. is a developer and distributor of a variety of computer software products, including business integration software, application integration solutions for enterprises, software for use in business to business integration, software for process management, mainframe integration solutions, business optimization software, data and metadata management software, and enterprise backbone solutions, and also offers a variety of related computer and educational services.
- 6. TIBCO Software Inc. is the owner of U.S. Registration Nos. 2770781 and 2770804 for the marks TIBCO and TIBCO and Design in International Classes 9, 41, and 42. See printouts of registration information attached as Exhibit A.

- 7. TIBCO Software Inc. is the owner of U.S. Registration No. 1659536 for the mark TIB for "computer software in the field of communication between computer processes" in International Class 9, and is also the owner of U.S. Registration No. 2288483 for the mark TIB/ACTIVE ENTERPRISE for "computer software for distributed systems development, operation and support, used in the field of software application integration," in International Class 9. See printouts of registration information attached as Exhibit B.
- 8. TIBCO Software Inc. is the owner of U.S. Registration No. 2,688,187 for the mark TIBCO PORTALBUILDER for a variety of goods in International Class 9, and is also the owner of U.S. Registration No. 2693046 for the mark TIBCO RENDEZVOUS for a variety of goods in International Class 9. See printouts of registration information attached as Exhibit C.
- 9. TIBCO Software has spent a considerable amount of money marketing its TIBCO products, and consumers are familiar with its products offered under the trademark TIBCO.
- 10. Opposer's TIBCO trademarks are of significant value to Opposer as identifiers of source in connection with the promotion and offering of its products and services.
- 11. Upon information and belief, Applicant has based its application upon a bona fide intention to use the mark in commerce and has not filed a use statement

before the U.S. Patent and Trademark Office, and accordingly, priority is not in issue.

- 12. Applicant's use of the mark TIBERO in connection with "recorded computer operating program; notebook computer; laptop computer; software programmable microprocessors; CD-Rom drive; magnetic tape drive; computer software for use as an enterprise application integration solutions, namely, providing integrated interface between various enterprise applications and user applications, which is recorded in floppy disk, CD-Rom, or magnetic tape device, or downloaded from a website" is likely to cause confusion with Opposer's various TIBCO and TIB trademarks as used in connection with Opposer's goods and services.
- 13. Applicant's use of the mark TIBCO in connection with "recorded computer operating program; notebook computer; laptop computer; software programmable microprocessors; CD-Rom drive; magnetic tape drive; computer software for use as an enterprise application integration solutions, namely, providing integrated interface between various enterprise applications and user applications, which is recorded in floppy disk, CD-Rom, or magnetic tape device, or downloaded from a website" will result in confusion, mistake, and/or deception in that the public will wrongly assume that Opposer has approved of Applicant, is affiliated with Applicant, or has otherwise sanctioned or sponsored the goods of Applicant.

14. Opposer would be damaged by the registration of the mark TIBERO by Applicant as the registration will result in confusion, mistake, and/or deception, and Applicant will be able to trade on Opposer's goodwill and reputation.

WHEREFORE, Opposer prays that this opposition be granted and that Applicant's application for the mark TIBERO be abandoned.

Respectfully submitted,

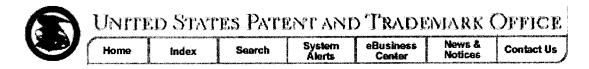
TIBCO SOFTWARE INC.

Dated: 6 22 54

Lori M. Stockton

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP 12400 Wilshire Boulevard Seventh Floor Los Angeles, CA 90025 (310) 207-3800

EXHIBIT A



TESS was last updated on Thu Jun 17 04:39:42 EDT 2004



(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark Goods and Services **TIBCO**

IC 009. US 021 023 026 036 038. G & S: computer hardware and software for use in integrating databases, email, search engines, content management, knowledge management, and applications on a global computer network; computer software for use in enterprise application integration, namely, to enable secure delivery of information, data, software, and network services between disparate software applications and systems over computer networks; computer hardware and communications software for use in conducting and processing online business transactions; computer software for use in automating online business networks; computer software and hardware for use in computer networking; computer hardware and software for network monitoring and management; computer databases in the field of business and communications recorded on computer servers; communication equipment, namely, computer hardware and communications servers; computer software for use in deploying and accessing interactive business services; computer software for use in development, customization, administration, and maintenance of web sites and portals, FIRST USE: 19960300. FIRST USE IN COMMERCE: 19960300

IC 042. US 100 101. G & S: computer consulting services; installation, maintenance and updating of computer software; technical support services, namely, monitoring network systems, providing back-up computer programs and facilities, and troubleshooting of computer hardware and software problems. FIRST USE: 19960300. FIRST USE IN COMMERCE: 19960300

IC 041. US 100 101 107. G & S: educational services, namely, providing classes, seminars, conferences, and workshops in the field of computer software. FIRST USE: 19960300. FIRST USE IN COMMERCE: 19960300

Mark

Drawing

(1) TYPED DRAWING

Code

Serial Number

76303227

Filing Date

August 20, 2001

Current Filing Basis

1**A**

Original

Filing Basis

1A

Published for Opposition

July 15, 2003

Registration

2770781

Number Registration

Date

October 7, 2003

Owner

(REGISTRANT) TIBCO Software Inc. CORPORATION DELAWARE 3165

Porter Drive Palo Alto CALIFORNIA 94304

Attorney of

Record

Lori M. Stockton

Prior

Registrations

1659536

Type of Mark TRADEMARK. SERVICE MARK

Register

PRINCIPAL

Live/Dead **Indicator**

LIVE

PTO HOME

TRADEMARK TESS HOME CURR LIST

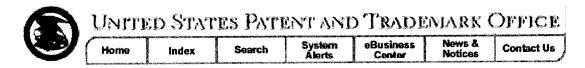
NEW USER FIRST DOC

STRUCTURED FREE FORM BROWN DICE PREV DOC NEXT DOC LAST DOC

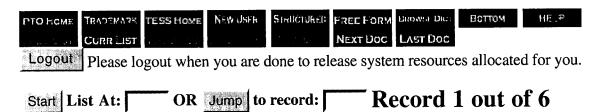
Tor

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Word Mark

TIBCO

Goods and Services

IC 009, US 021 023 026 036 038. G & S: COMPUTER HARDWARE AND SOFTWARE FOR USE IN INTEGRATING DATABASES, EMAIL, SEARCH ENGINES, CONTENT MANAGEMENT, KNOWLEDGE MANAGEMENT, AND APPLICATIONS ON A GLOBAL COMPUTER NETWORK; COMPUTER SOFTWARE FOR USE IN ENTERPRISE APPLICATION INTEGRATION, NAMELY, TO ENABLE SECURE DELIVERY OF INFORMATION, DATA, SOFTWARE, AND NETWORK SERVICES BETWEEN DISPARATE SOFTWARE APPLICATIONS AND SYSTEMS OVER COMPUTER NETWORKS; COMPUTER HARDWARE AND COMMUNICATIONS SOFTWARE FOR USE IN CONDUCTING AND PROCESSING ONLINE BUSINESS TRANSACTIONS; COMPUTER SOFTWARE FOR USE IN AUTOMATING ONLINE BUSINESS NETWORKS: COMPUTER SOFTWARE AND HARDWARE FOR USE IN COMPUTER NETWORKING; COMPUTER HARDWARE AND SOFTWARE FOR NETWORK MONITORING AND MANAGEMENT; COMPUTER DATABASES IN THE FIELD OF BUSINESS AND COMMUNICATIONS RECORDED ON COMPUTER SERVERS; COMMUNICATION EQUIPMENT, NAMELY, COMPUTER HARDWARE AND COMMUNICATIONS SERVERS; COMPUTER SOFTWARE FOR USE IN DEPLOYING AND ACCESSING INTERACTIVE BUSINESS SERVICES; COMPUTER SOFTWARE FOR USE IN DEVELOPMENT, CUSTOMIZATION, ADMINISTRATION, AND MAINTENANCE OF WEB SITES AND PORTALS. FIRST USE: 19960200. FIRST USE IN

COMMERCE: 19960200

IC 042. US 100 101. G & S: COMPUTER CONSULTING SERVICES; INSTALLATION, MAINTENANCE AND UPDATING OF COMPUTER SOFTWARE; TECHNICAL SUPPORT SERVICES, NAMELY, MONITORING NETWORK SYSTEMS, PROVIDING BACK-UP COMPUTER PROGRAMS AND FACILITIES, AND TROUBLESHOOTING OF COMPUTER HARDWARE AND SOFTWARE PROBLEMS. FIRST USE: 19960200. FIRST USE IN COMMERCE: 19960200

IC 041. US 100 101 107. G & S: EDUCATIONAL SERVICES, NAMELY, PROVIDING CLASSES, SEMINARS, CONFERENCES, AND WORKSHOPS IN THE FIELD OF COMPUTER SOFTWARE. FIRST USE: 19960200. FIRST USE IN COMMERCE: 19960200

Mark

Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design

Search Code

071107 260921

Serial

76324928 Number

Filing Date

October 15, 2001

Current

Filing Basis

Original

1A Filing Basis

Published for Opposition

July 15, 2003

Registration

Number

2770804

1**A**

Registration

Date

October 7, 2003

Owner

(REGISTRANT) TIBCO Software Inc. CORPORATION DELAWARE 3165

Porter Drive Palo Alto CALIFORNIA 94304

Attorney of

Record

Lori M. Stockton

Prior

Registrations 1659536

Type of Mark TRADEMARK. SERVICE MARK

Register

PRINCIPAL

Live/Dead

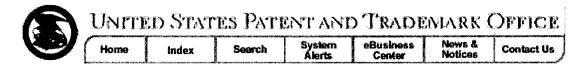
Indicator

LIVE

NEW USER STAUGICHER FREE FORM BROWN DIC: HELP TESS HOME Tor TRADEMARK PTO HOME LAST DOC CURR LIST NEXT DOC

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Start List At: OR Jump to record: Record 23 out of 24

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Typed Drawing

Word Mark

TIB

Goods and Services

IC 009. US 038. G & S: computer software in the field of communication between computer processes. FIRST USE: 19900700. FIRST USE IN

COMMERCE: 19900700

Mark Drawing

Code

(1) TYPED DRAWING

Serial Number

74089504

Filing Date

August 20, 1990

Current Filing

Basis

1A

Original Filing

Basis

1A

Published for Opposition

July 16, 1991

Registration

Kegistrai

1659536

Number

Registration

October 8, 1991

Date Owner

(REGISTRANT) Teknekron Software Systems, Inc. CORPORATION NEVADA Suite 301 530 Lytton Avenue Palo Alto CALIFORNIA 94301

(LAST LISTED OWNER) TIBCO SOFTWARE INC. CORPORATION BY

MERGER, BY CHANGE OF NAME, BY ASSIGNMENT, BY

ASSIGNMENT DELAWARE 3165 PORTER DRIVE PALO ALTO

CALIFORNIA 94304

Assignment

ASSIGNMENT RECORDED Recorded

Attorney of

Record

LORI M STOCKTON

Type of Mark

TRADEMARK

Register

PRINCIPAL

Affidavit Text

SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20020624.

Renewal

1ST RENEWAL 20020624

Live/Dead **Indicator**

LIVE

PTO HOME TRADEMARK

TESS HOME CURR LIST

NEW USER

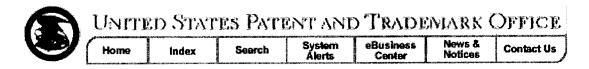
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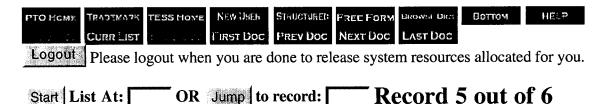
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Typed Drawing

Word Mark

TIB/ACTIVE ENTERPRISE

Goods and Services

IC 009, US 021 023 026 036 038. G & S: Computer software for distributed systems development, operation and support, used in the field of software

application integration. FIRST USE: 19980209. FIRST USE IN

COMMERCE: 19980209

Mark Drawing

Code

(1) TYPED DRAWING

Serial Number

75378577

Filing Date

October 24, 1997

Current Filing

Basis

1A

Original Filing

1B

Basis

Published for

Opposition

August 3, 1999

2288483

Registration

Number

Registration

October 26, 1999

Date Owner

(REGISTRANT) TIBCO Software Inc. CORPORATION DELAWARE 3165

Porter Drive Palo Alto CALIFORNIA 94304

Attorney of

Record

MICHAEL A EPSTEIN

Type of Mark

TRADEMARK

Register

PRINCIPAL

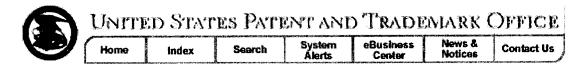
Live/Dead Indicator

LIVE



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Typed Drawing

Word Mark TIBCO PORTALBUILDER

Goods and Services

IC 009. US 021 023 026 036 038. G & S: Computer software for use in deploying and accessing interactive business services; computer software for use in conducting and processing online business transactions; computer software for use in automating online business networks; computer software for use in development, customization, administration and maintenance of web sites and portals; computer software for integrating email, search engines, content management, knowledge management, and applications on a global computer network; communications software, namely, to enable secure delivery of information, data, software, and network services between disparate software applications and systems over computer networks. FIRST USE: 19990900.

FÎRST USE IN COMMERCE: 19990900

Mark **Drawing**

(1) TYPED DRAWING

Code Serial

76334150

Number

Filing Date

November 5, 2001

Current

1A Filing Basis

Original Filing Basis

Published for November 26, 2002 **Opposition**

Registration

2688187

Number

Registration

Date

February 18, 2003

Owner

(REGISTRANT) Tibco Software Inc. CORPORATION DELAWARE 3165

Porter Drive Palo Alto CALIFORNIA 94304

Attorney of

Record

Lori M. Stockton

Type of Mark TRADEMARK

Register

PRINCIPAL

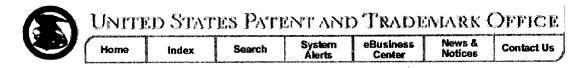
Live/Dead

Indicator

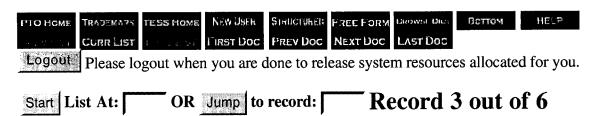
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Typed Drawing

Word Mark TIBCO RENDEZVOUS

Goods and Services

IC 009. US 021 023 026 036 038. G & S: computer software for use in enterprise application integration, namely, a messaging tool to be used by application developers and network systems managers to build scalable distributed applications, to enable diverse applications to share data across local area networks and wide area networks and facilitate communications between various enterprise applications. FIRST USE: 20000600. FIRST USE IN COMMERCE: 20000600

Mark

Drawing Code

(1) TYPED DRAWING

Serial

76409964

Number

May 20, 2002

Filing Date Current

1A

Filing Basis

Original **Filing Basis**

1A

Published for

December 10, 2002

Opposition Registration

2693046

Number

Registration Date

March 4, 2003

Owner

(REGISTRANT) TIBCO Software Inc. CORPORATION DELAWARE 3307

Hillview Palo Alto CALIFORNIA 94304

Attorney of

Record Lori M. Stockton

Type of Mark TRADEMARK

Register

PRINCIPAL

Live/Dead Indicator

LIVE



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